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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,393	10/20/2005	Augustin Chen	2005_1508A	1254

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EXAMINER	
REDDY, KARUNA P	

ART UNIT	PAPER NUMBER
1713	

DATE MAILED: 11/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/550,393	CHEN ET AL.	
	Examiner	Art Unit	
	Karuna P. Reddy	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) 1-23 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) 1-23 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 9/22/2005.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

   A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

   Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 17, 19-23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 19, 20 and 23 of US PG publication (US 2006/0036027 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to essentially the same composition.

   This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1- 18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,995,207 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims describe essentially the same composition.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation in claim 2 of "...per inch peel force with adhesive failure mode" is indefinite because the metes and bounds of such are not readily ascertainable.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3-15, 17-18, 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Biale (US 5,202,375).

The prior art of Biale discloses a polymer emulsion comprising 25 to 90 wt % of a hydrophobic soft monomer (abstract) exemplified by acrylic monomers including but not limited to butyl acrylate, isobutyl acrylate, ethylhexyl acrylate (column 3, lines 39-66); 10 to 75 wt % of a partially hydrophilic hard monomer (abstract) including, but not limited to methacrylic monomers such as methyl methacrylate, ethyl methacrylate, isobutyl methacrylate (column 3, lines 67-68; column 4, lines 1-64); about 1 to about 5 wt % of an hydrophilic mono-olefinic and di-olefinic carboxylic acids (abstract) including, but are not limited to, acrylic acid and methacrylic acid (column 2, lines 34-42); about 0.5 to about 5 wt % crosslinking agents (abstract) that include, but are not limited to diallyl maleate, diacrylates, dimethacrylates (column 2, 43-68; column 3, lines 1-12). Therefore, the polymeric emulsion comprising hydrophobic and hydrophilic monomers and crosslinking agents of instant claims is anticipated by Biale.

Claim Rejections - 35 USC § 102/103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

    1. Determining the scope and contents of the prior art.
    2. Ascertaining the differences between the prior art and the claims at issue.
    3. Resolving the level of ordinary skill in the pertinent art.
    4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 2 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over John Biale (US 5,202,375).

    The discussion with respect to Biale in paragraph 7 is incorporated herein by reference.

    The reference is silent with respect to the initial peel strength.

However, in light of the fact that the prior art teaches / discloses essentially the same composition as that of the claimed, one of ordinary skill in the art would have a reasonable basis to believe that the composition of the prior art exhibits essentially the same property(ies). Since the PTO cannot conduct experiments, the burden of proof is shifted to the applicants to establish an unobviousness difference. See In re Fitzgerald, 619 F. 2d. 67,205 USPQ 594(CCPA 1980).

Claim Rejections - 35 USC § 103

12. Claims 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Biale (US 5,202,375).

The discussion with respect to Biale in paragraph 7 is incorporated herein by reference.

However, prior art does not teach using ethyl acrylate as one of the partially hydrophilic hard monomer in the polymer.

However, prior art contemplates methacrylic monomers of formula $CH_2C(CH_3)(COOR)$ where R is an alkyl group that preferably contains upto 6 carbon atoms. In light of the above, it therefore would have been obvious to one of ordinary skill in the art at the time invention was made to use ethyl acrylate as a hard monomer, since this embodiment is within the generic disclosure of the reference and a skilled artisan would have expected all embodiments of a reference to work motivated by expectation of success.

13. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biale (US 5,202,375) in view of Avramidis et al (US 2002/0037956 A1).

The discussion with respect to Biale in paragraph 7 is incorporated herein by reference.

The prior art differs from the instant claims with respect to usage of allyl acrylate or allyl methacrylate as cross-linking agents.

However, prior art does not limit the cross-linking agents ((column 2, line 43-44) to those that are listed (column 2, lines 43-68; column 3, lines 1-12) and includes diallyl maleate. Avramidis et al disclose the crosslinking agents allyl methacrylate, allyl acrylate and diallyl maleate (page 2, 3, paragraph 0019). Therefore, it would have been obvious to one skilled in the art to use allyl acrylate or allyl methacrylate instead of diallyl maleate as crosslinking agents motivated by expectation of success since functionally equivalent components exhibit essentially similar reactivity.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karuna P. Reddy whose telephone number is (571) 272-6566. The examiner can normally be reached on Monday-Friday 8:30 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Karuna P Reddy
Examiner
Art Unit 1713

LING-SUI CHOI
PRIMARY EXAMINER